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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/648,456      | 08/26/2003  | Donald E. Godshaw    | 04286.00124         | 5091             |

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| EXAMINER |
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LARSON, JUSTIN MATTHEW

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3727

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 10/648,456             |  | GODSHAW ET AL.      |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Justin M. Larson       |  | 3727                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 2-4, 12, and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected embodiment, there being no allowable generic or linking claim. Election was made **without** traverse during a phone conversation with Mr. Jon Nelson on June 21<sup>st</sup>, 2005.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (US 5,964,384) in view of Miller (US 6,305,587).

Regarding claim 1, Young discloses a foldable luggage bag comprising, in combination: a first lesser capacity partial bag (20) made from a flexible material and including an outside surface (23) and an open periphery (30) with a first peripheral fastening mechanism (51) extending around the open periphery; a second flexible partial bag (60) of greater capacity than the first bag, said second bag formed of flexible material with an outside surface including a lateral side surface (23) formed at least in part by the outside surface of said first bag, said second partial bag including a separate section integrally attached to and extending from the open periphery (col. 3 lines 41-45) of the first bag with the first peripheral fastening mechanism maintained on the outside

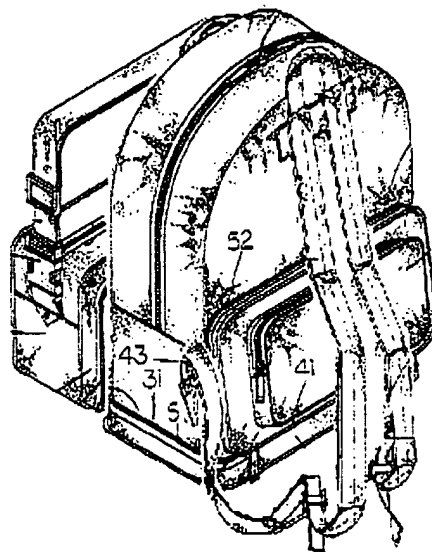
surface to enable forming a bag enclosure comprised of the volume of the first bag and the second bag, said second bag further including a second fastener mechanism (52) on the outside surface of said separate section, said second fastener mechanism having the same length as the first fastening mechanism and also fully attachable along its length to the first fastening mechanism, said second fastener mechanism encircling a part of the separate section of said second bag outside surface whereby the first fastener mechanism and the second fastener mechanism may be connected to enclose a portion of the separate section of the second bag within a volume comprised of the first bag and said part of the second bag part of the second bag encircled by the second fastener mechanism (Figure 1).

Young fails to disclose the first and second fastener mechanisms as being closed loop, as the fastener mechanisms are found on only three out of the four sides of the bags, the fourth side having a hinge located thereon.

Miller, however, discloses a similar bag configuration where a second bag is pulled from a first bag (Figures 9A and 9B) in order to provide a user with more storage space. Specifically, Miller teaches a first bag having a first closed loop fastener mechanism (102) encircling a periphery of the bag. A second bag is pulled out of the first bag, the second bag having a second closed loop fastener mechanism (102) on an outside surface thereof, the first and second fastener mechanisms operable to be joined together when containing the second bag within the first bag (Figure 1).

Referring back to Young, Young teaches that his bag system is convenient in that it allows a user to leave the contents of the first smaller bag in their place when

pulling out the second larger bag (col. 1 lines 55-59). Looking at the operation of Young's bag system (Figure 2), a user must first tip over the first smaller bag in order to pull out the second larger bag and use it as a backpack, effectively tipping over or disrupting the contents of the first smaller bag. Referring to the Miller bag system, the second larger bag can be pulled from the first smaller bag without having to tip over the first smaller bag. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the convertible bag of Young by forming the bag system in such a way that the second bag would be concealed within the first bag using closed loop fastener mechanisms, as taught by Miller, still providing the user the option of using a single smaller bag or pulling out a second larger bag for additional storage, but additionally and more conveniently allowing the contents of the first smaller bag to be even further unaffected during the bag conversion. Examiner submits the following figure to more clearly show the resulting combination of Young in view of Miller's teachings.



Regarding claim 5, the fastener mechanism of Young is in fact a zipper, effectively satisfying the limitations of the claim.

4. Claims 6-11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young in view of Miller, and further in view of Kepper (US 2,729,257).

Regarding claim 6, Young in view of Miller discloses the claimed invention, including the bag system being in the form of a backpack, said second partial bag comprising an enclosed bag with a bottom panel, a front panel including the first partial bag, a back panel spaced from the front panel, a connecting top and side panel joined to the bottom panel, back panel, and the front panels, a closure mechanism in the side panel which may be opened for access to the interior of the second bag, and at least one back strap attached to the back panel.

Young in view of Miller fails to disclose a user also having access to the interior of the first bag through the closure mechanism in the side panel of the second bag, as there is a panel (21, Young) separating the respective volumes of the first and second bags.

Kepper, however, teaches that when a convertible bag comprises a second bag (6) being pulled from a first bag (1), the panel (7) separating the respective volumes of the first and second bags may be detachable, allowing a user to access both of the bags' interiors through a single opening. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the bag system of Young in view of Miller by making wall (21) detachable, as taught by Kepper, in order to allow a user to store larger objects, objects that would otherwise be incapable of being

stored within the volume of a single bag, in a combination of both of the bags' volumes, increasing the utility of the expandable bag.

Regarding claim 7, the expandable bag of Young in view of Miller, and further in view of Kepper includes first and second back straps attached to the back panel, effectively satisfying the limitations of the claim.

Regarding claim 8, the straps of Young in view of Miller, and further in view of Kepper are adjustable, effectively satisfying the limitations of the claim.

Regarding claims 9 and 10, the expandable bag of Young in view of Miller, and further in view of Kepper includes a zippered access mechanism in the first partial bag, effectively satisfying the limitations of the claims.

Regarding claim 11, the expandable bag of Young in view of Miller, and further in view of Kepper comprises a front display panel (20, Young) and a circumferential side panel attached around a first edge of the front panel, effectively satisfying the limitations of the claim.

Regarding claim 14, the first bag of Young in view of Miller, and further in view of Kepper (20, Young) is positioned intermediate the bottom panel and top panel, effectively satisfying the limitations of the claim.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young in view of Miller and Kepper, and further in view of Bendersky (US 5,255,834). Young in view of Miller and Kepper discloses the claimed invention except for a display actually being on the display panel, which is located on the outside surface of the expanding bag.

Bendersky, however, teaches that it is old and well known in the art to provide displays on display panels that are located on outside surfaces of bags/packs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an image or display on an outside panel of the expanding bag, as taught by Bendersky, in order to provide an aesthetically appealing bag/pack to suit various consumer tastes.

### ***Response to Arguments***

6. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Art Unit: 3727

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Friday, 8am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JML  
12/16/05

  
NATHAN J. NEWHOUSE  
SUPERVISORY PATENT EXAMINER